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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Pierre-Alain Bauer

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EXAMINER

WALSH, DANIEL I

ART UNIT

PAPER NUMBER

2887

NOTIFICATION DATE

DELIVERY MODE

02/24/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Office Action Summary	Application No. 10/594,089	Applicant(s) BAUER, PIERRE-ALAIN	
	Examiner DANIEL WALSH	Art Unit 2887	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,9 and 10 is/are rejected.
- 7) ☒ Claim(s) 4,7,8 and 11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2006 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9-25-06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "the portion" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Objections

2. Claims 1, 3, 4, 7, 8, and 11 are objected to because of the following informalities:

Re claim 1, the Examiner suggests that the limitations do not appear to be positively recited. Accordingly, phrases such as "is placed" should be replaced with – placing – "a conducting wire is taken" should be replaced with – taking a conducting wire from a reel and placing it on the support such that at least one portion...-- and "the conducting wire is welded" should be replaced with – welding the conducting wire --. Similar changes apply for claim 3 as well, in order to positively recite the method steps.

Re claim 1, replace the phrase "a conducting wired intended to form an antenna" with – an antenna formed from conducting wire –, and subsequently replacing instances of "conducting

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wire” with – antenna formed from conducting wire --. Similar changes should apply to claim 3 and other dependent claims which recite the wire and should be changed to recite the antenna.

Re claims 4, 7, 8, and 11:

Claim 4 is a method claim that recites specific structural limitations. In order to be given patentable weight, they must affect the method claim in a manipulative sense. According, the Examiner suggests replacing “having...strips (2,3).” with – having an active portion with an end, and at the end of its active portion a recess (6), wherein the recess has a width that essentially corresponds to the gap between the two contact strips (2,3) enabling electrode to weld the antenna at the contact strip but not welding the wire between the contract strips disposed in the recess. – The Examiner suggests similar changes to claims 7, 8, and 11.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Halope (US 20030052177).

Re claim 1, Halope teaches a method of making a label where a chip is placed on a support piece so that the contact strips of the chip are situated on the side opposite to that in contact with the support piece (FIG. 2, FIG. 5 and claim 1, where the chip module comprising a

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chip and a circuit board support into the card structure and a conducting wire/antenna is taken and placed facing the contact strips/contacts of the chip and welded in a single operation (hot lamination)). Though silent to the wire taken from a reel, the Examiner notes that it is obvious to one of ordinary skill in the two contact strips of the chip and welded in a single operation (hot lamination²⁶ is placed on a support piece 10 to form a module 40 as per FIG. 5), so that the contact strips of the chip (34

5. Claims 1, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mundigl et al. (US 5809633).

Re claim 1, Mundigl et al. teaches a chip placed on a support piece so that the contact strips are situated opposite to that of the support piece, a conductive wire taken from a reel and positioned facing the contact strips and bonding to the strips (claim 1). Though silent to a single welding step, the Examiner notes that welding contacts to antennas is one of a plurality of ways to bond contacts to antennas, and therefore is an obvious expedient within the ordinary skill in the art for the expected result of a secure connection. As the bonding device handles the winding and bonding, it is interpreted as a single operation of the device.

Re claim 9, col 2, lines 55+ teaches finishing the card with a covering on the carrier body. Though silent to fibrous of plastic material surrounding the chip and antenna, the Examiner notes that the carrier body 1 is a flexible non conductive material. Further, the Examiner notes that paper/plastic are common materials for cards, and therefore their selection is well within the ordinary skill in the art for cost, acceptability, ease of manufacture, durability, etc.

Re claim 10, the limitations have been discussed re claim 1.

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6. Claims 1, 2, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finn et al. (US 6088230).

Re claim 1, Finn et al. teaches the chip placed on a support piece so that the contacts are opposite the support piece, a conducting wire taken from a reel so that at least one portion of the wire is positioned facing the contact strips, and securing to the contact strips in a single contact operation (FIG. 1). The Examiner has interpreted that a single contact operation takes place, as the machine automatically performs an operation to produce the device, and the automated process is interpreted as a single operation. Though silent to welding, Finn et al. teaches ultrasound, thermal compression, laser, and thermal fusing (col 4, lines 10+) for connecting the antenna. Therefore, the Examiner notes that the use of welding, as a connection means, is an obvious expedient, well within the ordinary skill in the art as a secure connection means.

Re claim 2, after the wire is connected to terminal 24, the Examiner notes that thereafter, the excess wire after the contact 24 (interpreted as now between the contacts 22 and 24), is then cut (col 4, lines 50+).

Re claim 10, the limitations have been discussed above.

7. Claims 3, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strache et al. (US 7151495).

Re claim 3, Strache et al. teaches a dipole antenna formed of two separate facing contact strips wherein the segments are welded (FIG. 1). Though silent to a single welding operation, the Examiner notes broadly interpreted that the operating of welding the antennas are interpreted as a single welding operation, that being a welding operation for antennas. Though silent to

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cutting, it would have been obvious to one of ordinary skill in the art that the antenna segments be cut to length to comply with the design of the transponder.

Re claim 5, the chip and antenna is embedded in an electrically non conductive material, including a thermoplastic elastomer, which is broadly interpreted to be functionally equivalent to two sheets of fibrous/plastic material, as it surrounds.

Re claim 6, the limitations have been discussed above.

Allowable Subject Matter

8. Claims 4, 7, 8, and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The prior art of record fails to teach the welding as claimed with the welding electrode having a recess as claimed so that the antenna wire on the contacts is welded but the antenna wire between the contacts and therefore in the recess is not welded.

Additional Remarks

As per the fees, claims 1 and 3 are interpreted as the 2 independent claims of the claim set.

The Examiner suggests that the method claims be amended to positively recite the active method steps, as mentioned in the claim objections, and clarifying that the antenna is formed from conductive wire so as to preclude wire bonding to chips/boards to read upon the claim limitations.

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The Examiner notes that if the Applicant wants to claim that the conducting wire is an antenna and that the label comprises a chip, that such limitations should be placed in the body of the claim, as well as the label limitation. Though the prior art teaches antennas, the Examiner notes that wires (such as connecting wires for chip pads/contacts) which are not wires, could be used to read on the claims, as the claims do not positively recite an antenna. In order to expedite prosecution, the Examiner suggests positive recitation in the body of the claim of the antenna, so as to preclude wire attachment (such as wired bonds) from an IC chip to a circuit/board to be used against the claims.

Further, "intended to form" is not a positive recitation. The Examiner suggests reciting in the body of the claim that the conducting wire is an antenna, for clarification, and also to mention the label in the body of the claim.

Additionally, the limitation that a portion of the wire is positioned "facing" two contact strips is very broadly, and wires around a perimeter can be interpreted as facing. If the Applicant desires to recite that the wire is laid on top of the chip so that the wire overlaps the contact strips and then subsequently welded that such limitations should be placed in the body of the claim.

With regard to the limitations that the wire/antenna between the strips is cut, the Examiner notes that wire can be in between the contact strips even if outside of the chip, as mentioned above. For clarification purposes, the Applicant could recite that the antenna between that contact strips and physically above/on top of the chip is what is cut.

With regards to the single welding operation, the Examiner notes that such a phrase is broad. If the Applicant wishes to claim that the antenna is welded to the contact strips of the

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electronic chip simultaneously through a welding electrode, that such limitations be placed in the claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL WALSH whose telephone number is (571)272-2409. The examiner can normally be reached on M-F 9am-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Paik can be reached on 571-272-2404. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DANIEL WALSH/
Primary Examiner, Art Unit 2887